

The indication that Applicant is required to surrender the "defective patent" has been noted, and the original patent will be surrendered or an affidavit will be filed when the present application is noted as allowable.

Initially, Applicant and Applicant's representative would like to thank Examiner Grant, II for the interview granted on December 21, 1999. During that interview, the outstanding rejection was discussed in detail. Further, during that interview Applicant's representative presented arguments to Examiner Grant, II that newly submitted Claims 12-47 of the present reissue application did not improperly try to recapture claimed subject matter deliberately canceled in the parent of the present application. Examiner Grant, II indicated that he would have to further consider that issue when a response traversing that issue was formerly presented.

Addressing now the rejection of Claims 12-47 under 35 U.S.C. §251, it is respectfully submitted that Claims 12-47 do not improperly recapture deliberately canceled claim subject matter.

It is well established that a reissue application will not be granted to "recapture" claimed subject matter deliberately canceled in an application to obtain a patent. However, it is not the situation in the present application that newly submitted Claims 12-47 of the reissue application capture previously deliberately canceled claim subject matter.

As stated in MPEP §1412.02:

Impermissible recapture occurs in a reissue where the claims in the reissue are of the same scope as, or are broader in scope than, claims deliberately canceled in an application to obtain a patent. Where such claims also include some narrowing limitation not present in the claims deliberately canceled in the application, the examiner must determine whether that narrowing limitation has a material aspect to it. *If the narrowing limitation has a material aspect to it, then there is no recapture. However, if the narrowing limitation is incidental, mere verbiage, or would be inherent even if not recited (in view of the specification), then the claims should be rejected under 35 U.S.C. 251 using form paragraph 14.17. (Emphasis added).*

As recognized in the outstanding Office Action, new Claims 12-29 recite that the printer module includes "a first frame" and the scanner module includes "a second frame, different from the first frame". Those features recited in new Claims 12-29 were never presented during the prosecution of U.S. Application 08/215,608, on which the present reissue application is based.

Moreover, such additional limitations to new Claims 12-29 do have a material aspect to them as they further define the structure of both the printer and scanner module. That is, such claim limitations are not "incidental", "mere verbiage" and would not be "inherent" to the original claims. As such, based on the guidelines provided in MPEP §1412.02 noted above, such limitations in Claims 12-29 prevent the rejection under 35 U.S.C. §251.

Similarly, new Claims 30-47 recite additional limitations of "first means for supporting elements of the printer module including the means for generating, the print control means, and the means for supplying power" and "second means for supporting elements of the scanner module including the means for scanning and the scanner control means, said second means for supporting different from the first means for supporting". Such limitations recited in new Claims 30-47 are also directed to a material aspect of the present invention and are not merely "incidental", "mere verbiage", or "inherent".

The basis for the outstanding rejection also cites the holding in *In re Clement*, 45 USPQ2d 1161 (Fed. Cir. 1997), as supporting the outstanding rejection. However, it is noted that the situation addressed in *In re Clement* is not the same situation as in the present invention. It is significant to note that in the holding in *In re Clement* an example was given of a situation in which reissue claims were broader in some aspects and narrower in other aspects than amended claims, and the Court addressed a situation that a reissue claim in question was as broad as or broader in an aspect germane to a patent rejection, but narrower

in another aspect completely unrelated to the rejection, i.e. situation 3a) noted in *In re Clement* and as noted in the outstanding Office Action. That situation was addressed in *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 994, 27 USPQ2d 1521, 1524 (Fed. Cir. 1993). In that case, the Court noted that the reissue claims in question eliminated limitations inserted into the claims during prosecution of the claims, but added additional limitations of a cylindrical member being "flexible" which formed a "single" roll. In that case, the Court held that the additional limitations of the cylindrical member being "flexible" and a "single roll" did not allow those claims to escape the recapture rule because those limitations did not "*materially narrow* the claim[s]" (emphasis added). Again, that is contrary to the case in the present application in which the additional limitations of the "first and second frames" in Claims 12-29 and the "first and second means for supporting" recited in Claims 30-47 do materially narrow the claims.

In such ways, it is respectfully submitted that Claims 12-47 presented in the present reissue application are proper and do not recapture subject matter canceled in the parent of the present application. Thus, it is respectfully submitted that the rejection of Claims 12-47 under 35 U.S.C. §251 has been traversed.

As no other issues are pending in this application, it is respectfully submitted that the present application is now in condition for allowance, and it is hereby respectfully requested

that this case be passed to issue.

Respectfully submitted,

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